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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,412

12/23/2003

Ikuro Kawauchi

Q79133

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06/22/2006

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,412	<b>Applicant(s)</b> KAWAUCHI ET AL.	
	<b>Examiner</b> Barbara L. Gilliam	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 6, 2006 has been entered.

### ***Response to Amendment***

1. The amendment filed April 6, 2006 has been entered and fully considered.
2. The amendment to the claims is supported by the specification and no new matter has been introduced.
3. Claims 1-10 and 13 are present of which claim 13 is new.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyake et al. (EP 909 657 A2).

a. The positive type photosensitive image-forming material for use with an infrared laser of Miyake et al. meet the present limitations for the infrared-sensitive lithographic printing plate. Specifically the positive type photosensitive image-forming material of Miyake et al. comprises a layer (A) which contains no less than 50% by weight of a copolymer which contains, as a copolymerization component, not less than 10 mol % of at least one of monomers (a-1) to (a-3) wherein monomer (a-1) has a sulfonamide group. Examples of monomer (a-1) include compounds represented by general formula (IV) to (VIII), all of which meet the present limitations for compound (B) ([0021]-[0023]). As copolymerization components, the monomer represented by general formula (IX) wherein X is NH and R<sup>2</sup> is an arylene group or aralkylene group, meet the present limitations for copolymer (A), specifically the monomer represented by a-8 ([0024]-[0028]). Other copolymerization monomers include styrenes such as styrene,  $\alpha$ -methylstyrene, methylstyrene, chloromethylstyrene, (meth)acrylates, (meth)acrylamides ([0024]:(1)-(4),(7)). It would have been obvious to use any combination of the monomers taught by Miyake et al. such as one of the compounds represented by general formula (IV) to (VIII) with the monomer of general formula (IX), methylstyrene and an acrylate in an amount of not less than 50% by weight in order to improve plate wear resistance ([0028]). Polymer compound having a phenolic hydroxyl group, such as resole-type phenol resin, novolak-type phenol resin can be contained in layer (A) ([0029]-[0031]). According to the teachings of Miyake et al. it is necessary to add at least one of the compounds which generates heat upon absorbing light, such as

Art Unit: 1752

dyes or pigments to the layer (B) and they may be added to layer (A) as well ([0084]-[0094]). See Examples.

5. Claims 1-10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al. (EP 1 219 464 A2)

a. The lithographic printing plate precursor of Tomita et al. meet the present limitations for the infrared-sensitive lithographic printing plate. Specifically the lithographic printing plate precursor of Tomita et al. comprises a metal support and an image-forming layer containing a light-to-heat converting agent (abstract). The thermal positive type comprises at least a high molecular compound, such as novolak type phenolic resins, copolymers comprising monomeric units represented by formula (I), (II) or (III) and copolymers comprising monomers represented by formula (IV)-(VIII) ([0121]-[0124]; [0128]). The copolymers comprising monomeric units represented by formula (I) wherein X is NH and  $R^2$  is an arylene group or aralkylene group meet the present limitations for the copolymer (A), specifically the monomeric unit represented by formula a-8. The copolymers comprising monomeric units represented by formula (IV)-(VIII) meet the present limitations for the compound (B). Other copolymer components include acrylates, methacrylates, styrenes, acrylamides and methacrylamides ([0127]).)). It would have been obvious to use any combination of the monomers taught by Tomita et al. such as one of the compounds represented by general formulae (IV)-(VIII)) with the monomer of general formula (I), methylstyrene and an acrylate in an amount of 5 to 99 wt % in order to obtain optimal sensitivity and durability ([0128]). The light-to-

heat converting agent is preferably added in an amount from 5 to 40 wt% ([0222]-[0230]).

### ***Response to Arguments***

3. Applicant's arguments filed April 6, 2006, with respect to the rejection(s) of the claims under 35 USC 102 have been fully considered and are persuasive in light of the amendment to independent claim 1. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made under 35 USC 103(a) in view of Miyake et al. and Tomita et al.

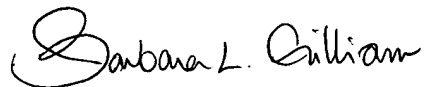
### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1752

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Barbara L. Gilliam". The signature is written in a cursive, flowing style.

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
June 16, 2006